

Atty. Docket No. DE9-1999-0077
(590.161)

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action in light of the following remarks.

Claims 1-14 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1, 10, and 12 are independent claims; the remaining claims are dependent.

The Applicants intend no change in the scope of the claims by the changes made by these amendments. It should also be noted that these amendments are not in acquiescence of the Office's position on the allowability of the claims, but merely to expedite prosecution. Reconsideration and withdrawal of the aforementioned rejections is respectfully requested.

Claims 1-9 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants' regard as their invention. Claims 12 stands rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1-5 and 8 stand rejected under 35 USC 102(e) as being anticipated by Kravitz, U.S. Patent No. 6,029,150. Claims 6, 7 and 10-13 stand rejected under 35 USC 103(a) as unpatentable over Kravitz in view of Martino, U.S. Patent No. 6,574,314. Claim 9 stands rejected under 35 USC 103(a) as unpatentable over Kravitz in view of Herlin et al., U.S. Patent No. 6,023,689. Claim 14

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stands rejected under 35 USC 103(a) as unpatentable over Kravitz in view of Martino and Fitzgerald et al., EP 0,940,783.

35 USC 112 Rejections

At the time of the instant Office Action the preamble to Claim 1 read "[a] provider offering goods and/or services...". It is the Examiner's position that such language does not adequately provide whether both elements are required or merely one of the two. To expedite prosecution, Claim 1 and, therefore, dependent Claims 2-9, have been amended to recite, inter alia, "provider offering goods or services." Claim 10 has been amended in a similar manner. The amended claims particularly point out and distinctly claim the subject matter which the applicant regards as its invention; therefore, the Applicants respectfully request withdrawal of the 35 USC 112, second paragraph, rejections.

35 USC 101 Rejections

Claim 12 stands rejected under 35 USC 101 as being directed toward non-statutory subject matter. Specifically, the Examiner stated, "[C]laim 12 has no connection to the technological arts. None of the steps recited indicate any connection to a computer technology. The steps could be performed manually with only trivial involvement of a simple electronic device." The Applicant respectfully disagrees.

Claim 12 clearly indicates "A computer program product...run on an electronic communication device...". Furthermore, the steps in Claim 12 include, inter alia, receiving and transmitting an electronic bill via an electronic communication device. The

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Claim indicates a computer program product having practical application in the technical arts. However, in order to expedite prosecution, Claim 12 has been amended to recite, inter alia, receiving and transmitting via electronic communications. Since amended Claim 12 is clearly directed towards statutory subject matter it is requested that the 35 USC 101 rejection be withdrawn.

35 USC 102 Rejections

As indicated above, Claims 1-5 and 8 stand rejected under 35 USC 102 as being anticipated by Kravitz. For the reasons that follow withdrawal of the rejections is requested.

Claim 1 has been amended to recite, inter alia, the identity of said customer is authenticated by a telecommunications provider. In contrast to the limitation, Kravitz appears to teach a process in which the authentication and identification in which, "[m]essages transmitted between customer network software and the CTA are authenticated by means of a Diffie-Hellman key exchange mechanism." (Col. 19, lines 20-22 and Col. 29, line 19- Col. 32, line 54). To this end, a customer initially creates an account with a participating bank and installs the appropriate software onto the device to be used in the purchasing of goods. (Col. 22, lines 56-67) Use is made of a customer PIN, which "brands" the software to the particular customer and generates the Diffie-Hellman key(s) required for later use as mentioned above. (Col. 22, line 65 - Col. 23, line 3). The customer's PIN is required each time customer authenticates a transaction to the agent, (Col. 23, line 50-52), or otherwise uses the software (Col. 24, lines 19-30). The

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Kravitz authentication stands in contrast to the present invention's authorization by a communications provider. For example and broadly speaking, an embodiment of the present invention provides a method for a customer's authentication using the customer's international mobile subscriber identity (IMSI), which, in turn, can be securely stored within a communication device's subscriber identity module (SIM). (See Claim 15) The authentication of the customer in the present invention by a communications provider is a distinct element that is neither expressly or implicitly present in Kravitz.

As the Examiner is aware, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *E.g., Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Kravitz clearly fails to set forth an authorization by a communications provider as set forth in amended Claim 1, as well as the claims dependent thereon, the reference does not anticipate the present invention and the rejections should be properly withdrawn.

35 USC 103 Rejections

Claims 6, 7 and 10-13 stand rejected under 35 USC 103. Of these claims; 6 and 7 are dependent upon Claim 1; Claim 11 depends on independent Claim 10; and Claim 12 and 13 depend upon independent Claim 12. As was just discussed, Claim 1 has been amended to recite, inter alia, wherein the identity of said customer is authenticated by a telecommunications provider. Likewise, independent Claims 10 and 12 have been similarly amended.

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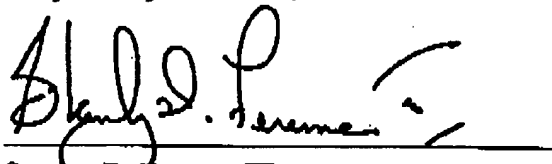
It is well established that a *prima facie* case of obviousness is only present if three basic criteria are met, specifically: (1) there must be some suggestion or motivation to modify or combine references; (2) a reasonable expectation that the modification or combination of references will prove successful; and (3) the prior art must teach or suggest all of the claim limitations. *See e.g., In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants' position is that none of the three criteria have been met with regard to the instant claims. As was indicated above, Kravitz clearly does not disclose a process in which a customer's identity is authenticated by a communications provider. None of the references cited by the Examiner suggest the use of such an authentication as a part of a method of payment by means of an electronic communication device. Furthermore, there exists no motivation to modify or combine the references in an attempt to achieve the present invention, where Kravitz itself appears to teach a secure method using keys between the payment provider and the customer. For these reasons the present invention as described by the amended claims are patentable over Kravitz in view of Martino; Herlin et al.; and/or Fitzgerald et al. and withdrawal of the rejections is requested.

The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

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In summary, it is respectfully submitted that the instant application, including Claims 1-17 is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stanley D. Ference III", is written over a horizontal line.

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